



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,781	02/24/2004	Gerhard D. Klassen	05200204-272US	2200

20988 7590 05/19/2011
OGILVY RENAULT LLP
1, Place Ville Marie
SUITE 2500
MONTREAL, QC H3B 1R1
CANADA

EXAMINER

HEFFINGTON, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

2172

MAIL DATE	DELIVERY MODE
-----------	---------------

05/19/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/784,781	Applicant(s) KLASSEN ET AL.	
	Examiner JOHN HEFFINGTON	Art Unit 2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/9/10, 8/20/10, 12/7/10, 1/5/11, 3/7/11</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the request for continued examination dated 4 March 2011. Claims 1-51 have been canceled. Claims 52-111 are new. Claims 52-111 are pending and have been considered below.

Response to Arguments

1. Applicant's arguments with respect to independent claims 52, 58, 64, 70, 76, 85, 94, 103 have been considered but are moot in view of the new ground(s) of rejection.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 58-63, 70-75, 85-93 and 103-111 cite a medium or media. The specification does not disclose a medium or media.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 58-63, 70-75, 85-93 and 103-111 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims cite a medium or media comprising machine-readable instructions. The specification of the instant invention does not cite or reference a medium or media comprising machine-readable

Art Unit: 2172

instructions. A medium or media could be a transmission signal or wave. A transmission signal or wave is none of process, machine, manufacture or composition of matter and, therefore is not a statutory category of invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 52-75, 83, 84, 92, 93, 101, 102, 110, 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US 2004/0155908 A1) in view of Canfield et al. (US 2004/0056893 A1).

1 - 51. (Cancelled)

Claim 52. Wagner discloses a method of providing notifications of unread messages on a wireless communication device (paragraph 0003 [This invention relates generally to mobile devices, and more particularly to software and systems for user interfaces on mobile devices.]), comprising: displaying at least one icon relating to electronic messaging on a graphical user interface of the wireless communication device; receiving a plurality of electronic messages on the wireless communication device, the plurality of electronic messages including messages from a plurality of different messaging correspondents (paragraph 0064 [For example in FIG. 5A, the mobile device displays a ski service 502, a news service 504, a buddies service 506, a messaging service 508, ...], paragraph 0060 [As another example, a mail icon may display a counter that changes to indicate the number of unread messages a user has.], figure 3).

Wagner does not disclose in response to receiving at least one of the plurality of electronic messages, visually modifying at least one displayed icon relating to electronic messaging to include a numeric character representing a count of the plurality of different messaging correspondents for which one or more of the electronic messages have been received and remain unread, as disclosed in the claims. However, in the

Art Unit: 2172

same field of invention, Canfield discloses “ ... in another implementation, such devices [as a mobile telephone 192, a PDA 193] may themselves include the functionality of the general-purpose computer 170 and operate as the client device 120.” (paragraph 0026)

and “Once the new message is viewed or acknowledged, the indicator changes and the conversation counter 650 is updated to reflect one fewer message waiting to be viewed. ... Although not shown in FIG. 6, either the conversation counter 650, the indicator, or both, may distinguish between a new message received from an ongoing IM session and new message received as part of the initiation of a new IM session.” (paragraph 0054). Therefore, considering the teachings of Wagner and Canfield, it would have been obvious to one having ordinary skill in the art at the time of the invention to add in response to receiving at least one of the plurality of electronic messages, visually modifying at least one displayed icon relating to electronic messaging to include a numeric character representing a count of the plurality of different messaging correspondents for which one or more of the electronic messages have been received and remain unread to the teachings of Wagner. One would have been motivated to add in response to receiving at least one of the plurality of electronic messages, visually modifying at least one displayed icon relating to electronic messaging to include a numeric character representing a count of the plurality of different messaging correspondents for which one or more of the electronic messages have been received and remain unread to the

teachings of Wagner in order to provide the user with comprehensive statistics regarding concurrent messaging sessions (Canfield: paragraph 0052).

Claim 53: Wagner and Canfield disclose the method of claim 52, and Wagner further discloses displaying a plurality of icons including one or more application icons that are selectable to invoke respective ones of a plurality of applications on the wireless communication device (paragraph 0056 [The context-based display 300 presents services and applications to users utilizing icons. In the example of FIG. 3, the icons are displayed in various locations on the context-based display 300 dependent on predicted usage.], figure 3).

Claim 54. Wagner and Canfield disclose the method of claim 53, and Canfield further discloses visually modifying one or more of the plurality of icons to include a count of electronic messages that have been received and remain unread, as disclosed in the claims (paragraph 0026 [... in another implementation, such devices [as a mobile telephone 192, a PDA 193] may themselves include the functionality of the general-purpose computer 170 and operate as the client device 120."]). Therefore, considering the teachings of Wagner and Canfield, it would have been obvious to one having ordinary skill in the art at the time of the invention to add visually modifying one or more of the plurality of icons to include a count of electronic messages that have been received and remain unread to the

Art Unit: 2172

teachings of Wagner and Canfield. One would have been motivated to add visually modifying one or more of the plurality of icons to include a count of electronic messages that have been received and remain unread to the teachings of Wagner and Canfield in order to provide the user with comprehensive statistics regarding concurrent messaging sessions (Canfield: paragraph 0052).

Claim 55. Wagner and Canfield disclose the method of claim 52, and Wagner further discloses the at least one icon relating to electronic messaging being selectable to invoke an electronic messaging application (paragraphs 0060, [To further assist the user in service and application selection, embodiments of the present invention animate particular icons to indicate additional information regarding the particular service or application that the icon represents.], 0065, [In the example of FIG. 5A the user decides to view the news by selecting the news data service 504.])).

Claim 56. Wagner and Canfield disclose the method of claim 52 and Wagner further discloses displaying on the graphical user interface an identifier of the correspondent from whom at least one of the plurality of messages was received (paragraph 0080 [Then, for example, Bob may call the user and leave a voice mail for the user. In this example, the user action proxy 612 will notice that Bob is a common theme within the services and

Art Unit: 2172

applications, and as such, may send the user an alert indicating something important may be occurring regarding Bob.)).

Claim 57. Wagner and Canfield disclose the method of claim 52, and Wagner further discloses displaying on the graphical user interface at least one preview of content associated with at least one of the received electronic messages (paragraph 0060 [Then, to indicate new news has arrived, the news icon may animate to display an "unrolled" newspaper.], figure 3).

Claims 58-63 disclose a medium or media comprising machine-readable instructions executable by a processor of a wireless communication device similar to the method of claims 52-57 and are rejected with the same rationale.

Claim 64-69 disclose a computer-readable memory accessible by a processor of a wireless communication device, the memory comprising stored electronic data structures representing executable instructions similar to the method of claims 52-57 and are rejected with the same rational.

Claims 70-75 disclose a wireless communication device comprising: a processor; a display electrically coupled to the processor, the display presenting a graphical user interface; and a medium or media including machine-readable instructions executable

Art Unit: 2172

by the processor similar to the method claims 52-57 and are rejected with the same rational.

Claim 83. Wagner discloses the method of claim 80, but Wagner does not disclose responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to include a decreased count of electronic messages which remain unread, as disclosed in the claims. However, in the same field of invention, Canfield discloses "Once the new message is viewed or acknowledged, the indicator changes and the conversation counter 650 is updated to reflect one fewer message waiting to be viewed." (paragraph 0054), and "Conversation counter 650 may be updated to show that are no new IM messages waiting to be viewed." (paragraph 0059). Therefore, considering the teachings of Wagner and Canfield, it would have been obvious to one having ordinary skill in the art at the time of the invention to add responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to include a decreased count of electronic messages which remain unread to the teachings of Wagner. One would have been motivated to add responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to include a decreased count of electronic messages which remain unread to the teachings of Wagner in order to keep an accurate count of

Art Unit: 2172

unread messages so the user is not mislead about the number of unread messages after one or more messages have been read.

Claim 84. Wagner discloses the method of claim 80, but Wagner does not disclose responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to remove the count of electronic messages which remain unread, as disclosed in the claims. However, in the same field of invention, Canfield discloses "Once the new message is viewed or acknowledged, the indicator changes and the conversation counter 650 is updated to reflect one fewer message waiting to be viewed." (paragraph 0054), and "Conversation counter 650 may be updated to show that are no new IM messages waiting to be viewed."

(paragraph 0059). Therefore, considering the teachings of Wagner and Canfield, it would have been obvious to one having ordinary skill in the art at the time of the invention to add responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to remove the count of electronic messages which remain unread to the teachings of Wagner. One would have been motivated to add responsive to invoking the electronic messaging application, visually modifying at least one icon relating to the electronic messaging application to remove the count of electronic messages which remain unread to the teachings of Wagner in order to keep an accurate count of unread messages so the

Art Unit: 2172

user is not mislead about the number of unread messages after one or more messages have been read.

Claims 92-93 disclose a medium or media comprising machine-readable instructions executable by a processor similar to the method of claims 83-84 and are rejected with the same rational.

Claims 101-102 disclose a computer-readable memory accessible by a processor of a wireless communication device, the memory comprising stored electronic data structures representing executable instructions which similar to the method of claims 83-84 and are rejected with the same rational.

Claims 110-111 disclose a wireless communication device comprising: a processor; a display electrically coupled to the processor, the display presenting a graphical user interface; and a medium or media including machine-readable instructions executable by the processor similar to the method claims 83-84 and are rejected with the same rational.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2172

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 76-82, 85-91, 94-100, 103-109 are rejected under 35 U.S.C. 102(e) as being anticipated by Wagner (US 2004/0155908 A1).

Claim 76. Wagner discloses a method of providing notifications of unread messages on a wireless communication device (paragraph 0003 [This invention relates generally to mobile devices, and more particularly to software and systems for user interfaces on mobile devices.]), comprising:

- a. displaying at least one icon relating to an electronic messaging application on a graphical user interface of the wireless communication device; receiving on the wireless communication device a plurality of electronic messages associated with the electronic messaging application; and responsive to receiving at least one of the plurality of electronic messages: visually modifying at least one icon relating to the electronic messaging application to include a count of the plurality of electronic messages which remain unread (paragraph 0064 [For example in FIG. 5A, the mobile device displays a ski service 502, a news service 504, a buddies service 506, a messaging service 508, ...], paragraph 0060 [As another example, a mail icon may display a counter that changes to indicate the number of unread messages a user has.], figure 3); and

- b. displaying on the graphical user interface a text identifier associated with a correspondent from whom the at least one of the plurality of electronic messages was received (paragraph 0059 [Further, the text comprising each informational icon label 310 can be automatically updated as the state of that particular service changes as it applies to the particular user.], paragraph 0080 [Then, for example, Bob may call the user and leave a voice mail for the user. In this example, the user action proxy 612 will notice that Bob is a common theme within the services and applications, and as such, may send the user an alert indicating something important may be occurring regarding Bob.])).

Claim 77. Wagner discloses the method of claim 76, and Wagner further discloses the identifier associated with a correspondent from whom the at least one of the plurality of electronic messages was received comprising state information pertaining to the correspondent (paragraph 0059 [Further, the text comprising each informational icon label 310 can be automatically updated as the state of that particular service changes as it applies to the particular user.]).

Art Unit: 2172

Claim 78. Wagner discloses the method of claim 76, and Wagner further discloses displaying on the graphical user interface at least a preview of content associated with at least one of the received electronic messages (paragraph 0060 [Then, to indicate new news has arrived, the news icon may animate to display an "unrolled" newspaper.], figure 3).

Claim 79. Wagner discloses the method of claim 76, and Wagner further discloses displaying on the graphical user interface for a predetermined period of time at least a preview of content associated with at least one of the received electronic messages (paragraph 0060 [Then, to indicate new news has arrived, the news icon may animate to display an "unrolled" newspaper.], figure 3).

Claim 80. Wagner discloses the method of claim 76, and Wagner further discloses the at least one icon relating to electronic messaging being selectable to invoke an electronic messaging application (paragraphs 0060, [To further assist the user in service and application selection, embodiments of the present invention animate particular icons to indicate additional information regarding the particular service or application that the icon represents.], 0065, [In the example of FIG. 5A the user decides to view the news by selecting the news data service 504.]).

Art Unit: 2172

Claim 81. Wagner discloses the method of claim 80, and Wagner further discloses, responsive to invoking the electronic messaging application, navigating automatically to a graphical user interface comprising content associated with at least one of the received electronic messages (paragraphs 0060, [To further assist the user in service and application selection, embodiments of the present invention animate particular icons to indicate additional information regarding the particular service or application that the icon represents.], 0065, [In the example of FIG. 5A the user decides to view the news by selecting the news data service 504.]).

Claim 82. Wagner discloses the method of claim 80, and Wagner further discloses responsive to invoking the electronic messaging application within a predetermined time following receipt of at least one of the received electronic messages, navigating automatically to a graphical user interface comprising content associated with the at least one of the received electronic messages (paragraphs 0060, [To further assist the user in service and application selection, embodiments of the present invention animate particular icons to indicate additional information regarding the particular service or application that the icon represents.], 0065, [In the example of FIG. 5A the user decides to view the news by selecting the news data service 504.])).

Claims 85-91 disclose a medium or media comprising machine-readable instructions executable by a processor similar to the method of claims 76-82 and are rejected with the same rational.

Claims 94-100 disclose a computer-readable memory accessible by a processor of a wireless communication device, the memory comprising stored electronic data structures representing executable instructions which similar to the method of claims 76- 82 and are rejected with the same rational.

Claims 103-109 disclose a wireless communication device comprising: a processor; a display electrically coupled to the processor, the display presenting a graphical user interface; and a medium or media including machine-readable instructions executable by the processor similar to the method claims 76-82 and are rejected with the same rational.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN HEFFINGTON whose telephone number is (571)270-1696. The examiner can normally be reached on 8:30 am to 5:30 pm.

Art Unit: 2172

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boris M. Pesin can be reached on 571-272-4070. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Boris Pesin/
Supervisory Patent Examiner, Art
Unit 2172

JMH
5/8/11